



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,044	03/12/2004	Courtney W. Turpen	653.02	8581

7590 10/09/2007
Geoffrey T. Staniford
Dergosits & Noah LLP
Suite 1450
Four Embarcadero Center
San Francisco, CA 94111

EXAMINER

FETSUGA, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3751

MAIL DATE	DELIVERY MODE
-----------	---------------

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,044	Applicant(s) TURPEN, COURTNEY W.	
	Examiner Robert M. Fetsuga	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 08, 2007 & April 13, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 12, 2004 & August 31, 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3751

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 08, 2007 has been entered.

2. The drawings are objected to because Fig. 3 is missing a legend (as amended August 31, 2006), and material cross-hatching is inaccurate in Fig. 4B.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter added to claim 1, lines 6-7 (and similarly added to claims 9 and 22) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be

Art Unit: 3751

labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites an upper flange "disposed in a plane substantially above a horizontal plane of the pool surface". Claims 9 and 22 recite similar subject matter. This subject matter is not found in the originally filed disclosure and is

Art Unit: 3751

therefore considered to be new matter. The pool is not defined in the instant disclosure to the specificity claimed.

4. Claims 1, 9, 14 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as to whether the "pool" is intended to be part of the claimed combination since structure of the "spa assembly" is defined as being structurally related thereto (lns. 6-7), but no positive structural antecedent basis therefor has been defined. Claims 9 and 22 are similarly indefinite.

Claim 14 is unclear as to whether the "securing elements" is intended to be part of the claimed combination since structure of the "spa assembly" is defined as being connected thereto, but no positive structural antecedent basis therefor has been defined.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3751

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-7, 9 and 17-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by DeVane.

The DeVane reference discloses a spa assembly comprising: a shell including a tub portion 10, and a flange 12 having a spillway (Fig. 3); and plumbing elements including a suction component 23 and a return component 17, as claimed. Re claim 1, the shell is capable of being fitted into a gunite spa cavity as functionally recited at line 2, and in fact is supported in a cement cavity (swimming pool). Furthermore, the flange 12 is "disposed in a plane substantially above a horizontal plane of the pool surface", in that the flange is at least above the pool floor. Re claim 4, the "vacuum-formed" recitation is a product-by-process limitation which does not serve to limit the product claim. Re claim 9, the flange is capable of allowing masonry components to be laid thereon as functionally recited.

Art Unit: 3751

Applicant argues at pages 6-7 of the response filed March 08, 2007 DeVane does not disclose a spillway between a spa and a pool. The examiner disagrees as water could flow over the lower portion of flange 12 (Fig. 3). The structure recited in applicant's claims is fully met by the DeVane disclosure.

7. Claims 1, 4-7, 9-13 and 17-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Badon, Jr.

The Badon, Jr. (Badon) reference discloses a spa assembly comprising: a shell including a tub portion 12, and a flange 24 having a spillway 28; and plumbing elements including a suction component 44 and a return component 42, as claimed. Re claim 1, the shell is capable of being fitted into a gunite spa cavity as functionally recited at line 2, and in fact is supported in a cement cavity (col. 3 lns. 39-53). Furthermore, the flange 12 is "disposed in a plane substantially above a horizontal plane of the pool surface", as depicted in Fig. 1. Re claim 4, the "vacuum-formed" recitation is a product-by-process limitation which does not serve to limit the product claim. Re claim 9, the flange is capable of allowing masonry components to be laid thereon as functionally recited. Re claim 10, no sandbags are disclosed by Badon. Re claim 11, the flange is capable of receiving securing elements.

Art Unit: 3751

8. Claims 1, 4-14 and 17-21, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb and Craig et al.

The Holcomb reference discloses a spa assembly comprising: a shell including a tub portion 12 and a flange 13; and plumbing elements including a suction component 19 and a return component 18. Re claim 1, the shell is capable of being fitted into an existing spa cavity as functionally recited at line 2, and in fact is supported in a gunite cavity 37. Re claim 4, the "vacuum-formed" recitation is a product-by-process limitation which does not serve to limit the product claim. Re claim 6, the shell is considered to be "readily insertable and removable" in the same sense as with applicant's disclosed invention. Re claim 9, the flange is capable of allowing masonry components to be laid thereon as functionally recited, and in fact appears to be contemplated by Holcomb in the sentence bridging columns 2 and 3. Re claim 10, no sandbags are disclosed by Holcomb. Re claim 11, the flange is capable of receiving securing elements. Therefore, Holcomb teaches all claimed elements except for the provision of a spillway, and the provision of operating controls.

Although the shell of the Holcomb spa assembly does not include a spillway, as claimed, attention is directed to the

Art Unit: 3751

Craig et al. (Craig) reference which discloses an analogous spa assembly which further includes a shell 18 having a spillway 50. Therefore, in consideration of Craig, it would have been obvious to one of ordinary skill in the spa assembly art to associate a spillway with the Holcomb shell in order to enable installation adjacent a swimming pool. Re claim 1, when a spa shell is installed adjacent a swimming pool as taught by Craig, the upper flange of the shell is "disposed in a plane substantially above a horizontal plane of the pool surface" as illustrated in Fig. 1 of Craig, for example. Re claim 21, Craig also teaches the claimed subject matter as previously acknowledged by applicant.

Although the Holcomb spa assembly does not include operating controls, as claimed, attention is again directed to Craig which discloses operating controls C1. Therefore, in further consideration of Craig, it would have been obvious to one of ordinary skill in the spa assembly art to associate operating controls with the Holcomb spa assembly in order to facilitate operation.

Applicant argues at pages 7-8 of the response the Holcomb and Craig disclosures are not combinable because they are different systems. The examiner disagrees. Both Holcomb and Craig disclose spa assemblies. Craig further discloses combining a spa and a swimming pool in a smoothly integrated

Art Unit: 3751

manner. Note column 4, line 20 through column 5, line 43 in Craig. This disclosure in Craig also appears consistent with the discussion at pages 1-4 in the instant specification. Given these facts, it is the examiner's opinion one skilled in the spa/swimming pool art would find ample motivation to smoothly integrate the Holcomb spa into a swimming pool by associating a spillway with the spa. Thus, a prima facie case of obviousness has been established.

9. Claims 2, 3, 15, 16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb and Craig as applied to claims 1 and 9 above, and further in view of Price.

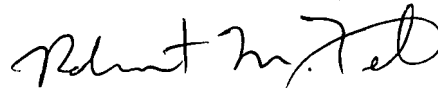
Although the shell of the Holcomb spa assembly does not include a notch, as claimed, attention is directed to the Price reference which discloses an analogous spa assembly which further includes a shell 17 having a notch 67. Therefore, in consideration of Price, it would have been obvious to one of ordinary skill in the spa assembly art to associate a notch with the Holcomb shell in order to enable tile installation. The choice of notch dimensions would appear an obvious choice to be made.

Applicant's arguments have been fully considered and have been previously addressed.

Art Unit: 3751

10. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

11. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

A handwritten signature in black ink, appearing to read "Robert M. Fetsuga", is positioned above the printed name.

Robert M. Fetsuga
Primary Examiner
Art Unit 3751